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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,463

12/29/2004

Eiji Isono

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EXAMINER

SPAHN, GAY

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,463

Applicant(s)

ISONO, EIJI

Examiner

Gay Ann Spahn

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007 and 22 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 May 2007 has been entered.

Drawings

The drawings filed on 31 August 2007 must have the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review" (i.e., PTO-948) corrected (sections lines 2-2 and 6-6 in Figs. 1 and 5 are informal as being hand-written and "Prior Art" legends in Figs. 5-7 are informal as being hand-written). In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Specification

The title of the invention is not descriptive. *A new title is required that is clearly indicative of the invention to which the claims are directed.*

The following title is suggested:

**GASKET FOR HARD DISK DRIVE HAVING COMPRESSIBLE
LIP AND EXTENSION PORTION AT SCREW FIXING/INFLECTION PORTIONS**

Claim Objections

Claim 4 is objected to because of the following informalities:

Claim 4, lines 2-6, the recitation of "the packing is integrally formed in the plate, and remnants of a pouring hole are arranged on the packing extension portion" is not clear because:

(1) the recitation of the packing integrally formed "in the plate" should be amended to language that the packing is formed --on the plate--; and

(2) the recitation of "remnants of a pouring hole are arranged on the packing extension portion" is not clear because a pouring hole does not have remnants and the examiner suggests amending to recite something similar to --elastomeric material left in the pouring hole of the mold used to form the packing forms a protrusion on top of the packing extension portion--.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art discussed in the "BACKGROUND ART" section of the specification on page 1, line 14 through page 2, line 20 and shown in Prior Art Figs. 5-7 (hereinafter referred to as "APPLICANT'S ADMITTED PRIOR ART") in view of SATO ET AL. '470 (Japanese Patent Application Publication No. JP 2001-311470).

As to claim 1, APPLICANT'S ADMITTED PRIOR ART discloses a gasket (51 in Figs. 5-7) comprising:

a plate (52) having a flat surface, said plate (52) being screwed to an opposing assembly member (55) at a screw fixing portion (56), and

a packing (53) bonded (see page 1, lines 16-19) to a peripheral area on the flat surface of said plate (52) in a predetermined pattern,

said packing (53) including:

a lip portion (54) raised from said base portion (unnumbered, but below lip portion 54 and above plate 52) and disposed at an outer peripheral side in a width direction of said packing (53), said lip portion (54) being bent to an inner peripheral side (see Fig. 7) of said plate (52) when said lip portion (54) is compressed by said opposing assembly member (55).

However, APPLICANT'S ADMITTED PRIOR ART fails to explicitly disclose an extension portion extending from said base portion toward the outer peripheral side of said plate near said screw fixing portion and an inflection portion of said base portion,

bottom surfaces of said base portion and said extension portion being contiguous on the flat surface of said plate.

SATO ET AL. '470 disclose a cover gasket (6 in Figs. 1 and 2) having a packing with a lip portion (8) and an extension portion (7) extending from said base portion (under lip 8) toward the outer peripheral side of said plate (1 and 2) near said screw fixing portion (4 in Fig. 1) and an inflection portion (at 4 in Fig. 1) of said base portion (under lip 8), bottom surfaces of said base portion (under lip 8) and said extension portion (7) being contiguous (see Fig. 2) on the flat surface of said plate (1 and 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of APPLICANT'S ADMITTED PRIOR ART by including an extension portion extending from the base portion toward the outer peripheral side of the plate near the screw fixing portion and an inflection portion of the base portion, wherein bottom surfaces of the base portion and the extension portion are contiguous on the flat surface of the plate as taught by SATO ET AL. '470 in order to prevent the separation of the gasket from the plate due to the increased bonded surface area upon separation of the plate and the opposing assembly member.

As to claim 5, APPLICANT'S ADMITTED PRIOR ART in view of SATO ET AL. '470 discloses the gasket of claim 1 as discussed above, and both APPLICANT'S ADMITTED PRIOR ART and SATO ET AL. '470 also disclose that the packing (55 in APPLICANT'S ADMITTED PRIOR ART; 6 in SATO ET AL. '470) is used as a cover gasket for electronic equipment (see first line of "BACKGROUND ART" section of

APPLICANT'S ADMITTED PRIOR ART; see last line of "PROBLEM TO BE SOLVED" of Abstract of SATO ET AL. '470).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art discussed in the "BACKGROUND ART" section of the specification on page 1, line 14 through page 2, line 20 and shown in Prior Art Figs. 5-7 (hereinafter referred to as "APPLICANT'S ADMITTED PRIOR ART") in view of SATO ET AL. '470 (Japanese Patent Application Publication No. JP 2001-311470), as applied to claim 1 above, and further in view of SATO ET AL. '125 (Japanese Patent Application Publication No. JP 2000-100125, but see English translation in U.S. Patent No. 6,623,684).

As to claim 4, APPLICANT'S ADMITTED PRIOR ART in view of SATO ET AL. '470 discloses the gasket of claim 1 as discussed above, and both APPLICANT'S ADMITTED PRIOR ART and SATO ET AL. '470 disclose that the packing is integrally formed in the plate.

Neither APPLICANT'S ADMITTED PRIOR ART nor SATO ET AL. '470 explicitly discloses that remnants of a pouring hole are arranged on the packing extension portion.

SATO ET AL. '125 disclose that remnants of a pouring hole (76 in Fig. 10) arranged on the packing extension portion (42 in Fig. 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of APPLICANT'S ADMITTED PRIOR ART in

view of SATO ET AL. '470 by including remnants of a pouring hole arranged on the packing extension portion as taught by SATO ET AL. '125 in order that a protrusion of elastomeric material left behind on the packing from the pouring hole trace need not be removed, but at the same time be capable of not interfering with the sealing capabilities of the gasket.

Response to Arguments

Applicant's arguments with respect to claims 1, 4, and 5 have been considered but are moot in view of the new ground of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various patents cited of interest as showing gaskets include: U.S. Patent No. 4,321,225 to Jelinek; and U.S. Patent No. 3,333,725 to Hirata et al.; U.S. Patent No. 3,510,139 to Potter; U.S. Patent No. 2,717,793 to Nenzell; U.S. Patent No. 3,061,321 to Smith; U.S. Patent Application Publication No. 2006/0131819 to Kurano et al.; U.S. Patent No. 6,837,498 to Fluck et al.; U.S. Patent No. 5,002,290 to Pernin; U.S. Patent No. 6,305,695 to Wilson; U.S. Patent No. 5,551,705 to Chen et al.; and U.S. Patent Application Publication No. 2004,0075224 to Kuroki et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-

7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gay Ann Spahn

Gay Ann Spahn, Patent Examiner
July 9, 2007